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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bsafe Online, Inc.

Serial No. 78115493

Kristin Jordan Harkins of Conley Rose, P.C.

Michele-Lynn Swain, Trademark Examining Attorney, Law
Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Hanak and Holtzman, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Bsafe Online, Inc. (applicant) seeks to register in
typed drawing form BSAFE ONLINE for "application service
provider featuring software for Internet filtering and
reporting thereof, for use by parents and other caregivers
of children, schools, churches and other religious
affiliates." The application was filed on March 18, 2002
with a claimed first use date of September 2001. Applicant
disclaimed the exclusive right to use ONLINE apart from the
mark in its entirety.

Citing Section 2(d) of the Trademark Act, the Examining Attorney has refused registration on the basis that applicant's mark, as applied to applicant's services, is likely to cause confusion with the mark BSAFE, previously registered in typed drawing form for "computer software to integrate cryptographic security features into software applications." Registration No. 2,227,325 issued March 2, 1999. When the refusal to register was made final, applicant appealed to this Board. Applicant requested a hearing which was held on April 21, 2004. At that hearing were applicant's counsel and the Examining Attorney.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the marks, we note at the outset that we are obligated to compare the marks "in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). However, in comparing the

marks in their entirety, it is completely appropriate to give less weight to a portion of the mark that is merely descriptive of the relevant goods or services. National Data, 224 USPQ at 751 ("That a particular feature is descriptive ... with respect to the relevant goods or services is one commonly accepted rationale for giving less weight to a portion of the mark."). In the first Office Action, the Examining Attorney stated that the ONLINE portion of applicant's mark was merely descriptive of applicant's services, and must be disclaimed. As previously noted, applicant then disclaimed the ONLINE portion of applicant's mark, thereby acknowledging that ONLINE was indeed merely descriptive of applicant's services.

Thus, applicant has appropriated the cited mark (BSAFE) in its entirety and merely added to this mark the descriptive word ONLINE. It has long been held that one may not appropriate the entire mark of another and escape liability by the addition thereto of merely descriptive or indeed even highly suggestive terminology. Bellbrook Dairies v. Hawthorn-Mellody Dairy, 253 F.2d 431, 117 USPQ 213, 214 (CCPA 1958) and cases cited therein.

Moreover, because applicant seeks to register its mark in typed drawing form, this means that any registration it

obtains is "not limited to the mark depicted in any special form." Hence, we are mandated to "visualize what other forms [applicant's] mark might appear in." Phillips Petroleum Co. v. C.J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). See also INB National Bank v. Metrohost Inc., 222 USPQ 1585, 1588 (TTAB 1992).

One reasonable presentation of applicant's mark would be to depict the BSAFE portion of the mark in very large lettering on one line, and depict the descriptive ONLINE portion of the mark on a second line in much smaller lettering. Indeed, applicant's own specimen of use shows that this is precisely how applicant depicts its mark. That is to say, the BSAFE™ portion of the mark is depicted in large lettering on one line and beneath it in much smaller lettering within a black rectangle there appears the ONLINE portion of applicant's mark. When applicant's mark is so depicted, it is nearly identical to the registered mark BSAFE.

Thus, the first Dupont "factor weighs heavily against applicant" because applicant's mark is nearly identical to the registered mark when the BSAFE portion of applicant's mark is depicted in large lettering on one line and the ONLINE portion is depicted within a black rectangle on a second line in much smaller lettering. In re Martin's

Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of applicant's services and registrant's goods we note that because the marks are nearly identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 922 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). There is no serious dispute as to what applicant's services and registrant's goods are. In this regard, applicant made of record the declaration of Darren Boisjolie, the Chief Technical Officer of applicant. In paragraph four of his declaration Mr. Boisjolie states that "cryptography is the technology of encoding information so it can only be used by authorized individuals." The Examining Attorney made of record a definition of "cryptography" from The High-Tech Dictionary which reads in a virtually identical manner as Mr. Boisjolie's declaration: "The technology of encoding information so it can only be read by authorized individuals." See also Webster's New World Dictionary (1996) which defines the related word "cryptography" as follows: "The art of writing or deciphering messages in code."

There is also no dispute as to what applicant's Internet filtering services are. In this regard, reference is made to paragraph 8 of Mr. Boisjolie's declaration which reads, in part, as follows: "Applicant corporation's filtering services are for consumers who wish to filter violent games, pornography, and other undesirable content from sites or e-mail from the view of children ... elderly people, or themselves."

Based on a review of the record, we find that the Examining Attorney has established that computer software having cryptographic security features (registrant's goods) and the services of Internet filtering and reporting for use by parents, children, schools, churches and other religious affiliates (applicant's services) are clearly related.

First, the Examining Attorney has demonstrated that some companies are manufacturing combination products which feature both filtering and cryptography (encryption). In this regard, the Examining Attorney has made of record a number of articles which demonstrate this very point. One such article is from the November 2001 issue of Information Security and it reads, in part, as follows: "Some vendors rolled out combination content filtering/encryption software." In addition, the Examining Attorney conducted a

Google search which showed that various companies are offering both filtering and cryptographic products and services.

Second, even if there was no evidence of products and services featuring both filtering and cryptographic security, there can be no serious dispute that many institutions would have a need for both filtering products and services and cryptographic products and services. Even if we assume arguendo the correctness of applicant's contention that cryptographic products are not purchased or used by individuals, it is obvious that they are used by institutions such as schools and churches, the very customer groups listed in applicant's identification of services. Obviously, a school must protect the privacy of, for example, a student's academic and disciplinary records. A school would therefore have to place such records on software which is cryptographic in the sense that it can be accessed only by authorized users, such as certain school administrators. Likewise, a school would have the need for filtering services and products to protect, as applicant's itself states, children (students) from pornographic and other objectionable websites and e-mail.

If a school administrator were to see virtually identical marks on Internet filtering services and

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cryptographic computer software, he or she would naturally assume that both related products emanated from a common source.

Decision: The refusal to register is affirmed.